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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,666	12/05/2005	Takao Shibata	Q91463	7227
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SUGHRUE MION, PLLC				
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SUITE 800				
WASHINGTON, DC 20037				
EXAMINER				
MULLS, JEFFREY C				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
06/23/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/559,666

**Applicant(s)**

SHIBATA ET AL.

**Examiner**

Jeffrey C. Mullis

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda (JP 07-331025).

Patentees disclose a composition which may contain as much as 99 % rubber modified styrenic resin and the remainder polyorganosiloxane based thermoplastic resin (see the Patent Abstracts of Japan abstract). The polysiloxane contains an agent "II" (as in applicants graft linking agent at a level of 0-1 %) or preferably 0.5-5% (paragraph 4). Twenty percent (but up to 200%) vinyl monomer may be polymerized in the polyorganosiloxane containing the graft liker in paragraph 5.

No examples exist in which all of applicants limitations are present in combination. However, to arrive at applicants composition by selecting from the various choices of the patent would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results basement any showing of surprising or unexpected results.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyatake et al. (US 2003/0092819).

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Patentees disclose a process in which polymerization of vinyl monomers (as in applicants vinyl monomer "C") is conducted in the presence of a silicone latex (i.e. grafted) with 5-40 parts monomer (paragraph 80). The silicone latex may contain 0-40% graftlinker or preferably 0.5-20% (paragraph 41).

No examples exist in which all of applicants limitations are present in combination.

However, to arrive at applicants composition by selecting from the various choices of the patent would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results basement any showing of surprising or unexpected results.

Applicant's arguments filed 3-21-08 have been fully considered but they are not persuasive. With regard to JP '025, it is true that none of the examples of the patent disclose all of the elements of the instant claims in combination. However, it is not the position of the examiner that JP '025 anticipates the claims. Applicants are correct that the preferable range of 0.5 to 5% for component "B" of JP '025 does not meet the limitations of the claims. However patentees broad range of 0-10% does overlap with the claimed range. While admittedly, the overlap is a less preferred range of JP '025 there is still sufficient motivation for those of ordinary skill in the art to operate within this range given that patentees disclose that it is workable. Admittedly, no amount of selecting from within the disclosure of the patent will result in applicants "a-1". However, only instant claim 2 (now allowable over JP '025) requires the presence of "a-1".

It is the position of the examiner that the ABS "thermoplastic" of Miyatake corresponds to applicants component "E" while Miyatakes "A" corresponds to applicants

"A".. The acrylic rubber of Miyatake does not appear to correspond to any of the claimed components although the open language of the claims do not actually exclude the acrylic rubber latex. In any case, with regard to applicants arguments in the second paragraph on page 12 of their remarks, 1-20% overlaps with 0.1-3% as recited by the claims. It is not the position of the examiner that any example discloses all of applicants limitations in combination and it is not the position of the examiner that Miyatke anticipates the claims. Applicants argue unexpected results. However, unexpected results must be with the closest prior art, MPEP 716. However the closest prior art in the instant case is one of the references relied upon and no data comparing examples according to the prior art with examples according to the invention in which only features by which the invention and prior art are varied have been presented.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis at telephone number 571 272 1075.

Jeffrey C. Mullis  
Primary Examiner  
Art Unit 1796

JCM

6-17-08

/Jeffrey C. Mullis/

Primary Examiner, Art Unit 1796